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| 08/962,971 | 10/27/1997 | NABIL N. GHALY | 1025-002P/JA | 9524 |
| 7590 | 05/16/2006 | | EXAMINER | |
| DR. NABIL N. GHALY 14 LONGWOOD DRIVE S. HUNTINGTON, NY 11746 | | | BROCKETTI, JULIE K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3713 | |

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Improper Amendment to Reissue

The amendment filed March 3, 2006 proposes amendments to the application that does not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental papers correctly amending the reissue application is required.

**A shortened statutory period for reply to this letter is set to expire
ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the
mailing date of this letter.**

37 CFR 1.173 (b) states

(b) ***Making amendments in a reissue application***. An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

(1) **Specification other than the claims**. Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.52(e)(1) and 1.821(c), but not for discs submitted under § 1.821(e)).

(2) **Claims**. An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) **Drawings**. One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall

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include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.

(i) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(ii) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(c) Status of claims and support for claim changes . Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) Changes shown by markings . Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and
(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(e) Numbering of patent claims preserved. Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) Amendment of disclosure may be required . The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) Amendments made relative to the patent. All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

Applicant has not complied with the rule for making claim amendments in a reissue application. **All amendments must be made with respect to the**

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original patent claims. In Applicant's case he cancelled all original patent claims and has added new claims 83-127. Therefore, these are still considered new claims with respect to the original patent so applicant needs to underline all of the claim language of these claims and should NOT include bracketing to show the deletions from the previous amendment. The status identifiers on all of the claims should read "NEW" or there should be no status identifiers. The status identifiers such as "Amended" etc., mentioned in the rule only apply to the original patent claims, but Applicant no longer has any original patent claims pending. Please see MPEP 1453(V)(D) which states how to perform amendments to new claims. It states: "*Amendment of New Claims*

An amendment of a "new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. The presentation cannot contain any bracketing or other indication of what was in the previous version of the claim. This is because all changes in the reissue are made vis- à-vis the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, applicant must point out what is changed in the "Remarks" portion of the amendment. Also, per 37 CFR 1.173(c), each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

All claims that applicant intends to cancel via the amendment should not have the text included in those claims the status identifier (Canceled) with no text is sufficient. For example claim 97 should have no text.

The Examiner does acknowledge that Applicant made the specification amendments correctly.

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Applicant must also comply with 37 CFR 1.173(c) which states

(c) *Status of claims and support for claim changes*. Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

Applicant has complied with the “support for the disclosure of the patent for the changes made to the claims” by supplying “Exhibit “A” Tabulation of Claim Limitations” which the Examiner greatly appreciates. However, Applicant has not complied with the part in which Applicant needs to show what changes the amendment makes with respect to the previous amendment. As a suggestion on how to comply with this, the Examiner suggests taking the previous set of claims submitted (the one with underlining and bracketing) and inserting a title such as “Exhibit B: Marked up version of the claims noting differences in currently pending claims and previously submitted claims from 5/27/2005”. Supplying this exhibit would comply with the requirement (keeping in mind that applicant would also submit the new copy of the claims all underlined) Applicant should reference both Exhibits in his “REMARKS” section so as to clearly indicate what each exhibit shows.

Applicant also has to indicate the status of all claims. It is noted that Applicant attempted to do this on page 13 of the “REMARKS” section, however, claims 1-82 which were cancelled were not mentioned. Please clearly describe which claims are cancelled and which claims are currently pending.

Applicant also has to begin each section of his amendment on a separate sheet. For example amendments to the specification should have begun on a clean sheet clearly labeled specification; same with the “Claims” and “Remarks” section. Each of these sections must begin on a separate sheet due to the electronic scanning procedures at the office. The following is section 714 (II)(A) of the MPEP while dealing with regular patent application is also applicable to reissue applications **only** in the context listed below.

A. Amendment Sections

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet to facilitate separate indexing and electronic scanning of each section of an amendment document for placement in an image file wrapper. It is recommended that applicants use the following format when submitting amendment papers. The amendment papers should include, in the following order:

- (A) *a cover sheet, or introductory comments, providing the appropriate application information (e.g., application number, applicant, filing date) and which serves as a table of contents to the amendment document by indicating on what page of the amendment document each of the following sections begin;*
- (B) *a section (must begin on a separate sheet) entitled “Amendments to the Specification” (if there are any amendments to the specification). This section should include all amendments to the specification including amendments to the abstract of the disclosure;*
- (C) *a section (must begin on a separate sheet) entitled “Amendments to the Claims” which includes a complete listing of all claims ever presented in the application (if there are any amendments to the claims); (Keeping in mind that the text of cancelled claims should not be included, just the status identifier “Cancelled”)*
- (D) *a section (must begin on a separate sheet) entitled “Amendments to the Drawings” in which all changes to the drawings are discussed (if there are any amendments to the drawings);*
- (E) *a remarks section (must begin on a separate sheet); and*
- (F) *any drawings being submitted including any “Replacement Sheet,” “New Sheet,” or “Annotated **>Sheet*

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Applicant has not answered any of the rejections made in the office action. 37 CFR 1.111(b) states:

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and **specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action.** The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

Applicant needs to clearly point out the supposed errors in the examiner's action with respect to the prior art, new matter rejections, 112 rejections etc.

Applicant must also sign the amendment at the end of the remarks section.

OTHER THINGS APPLICANT MAY WISH TO CONSIDER BUT ARE NOT REASONS WHY THE AMENDMENT IS NON-RESPONSIVE

If you are adding new drawings, you need to include reference to these drawings in the "Brief Description of Drawings" Section of the Specification.

Re-read the "New Matter" rejections. MPEP 1411.02 states:

New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251. The claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. Any change in the patent

made via the reissue application should be checked to ensure that it does not introduce new matter. Note that new matter may exist by virtue of the omission of a feature or of a step in a method. See United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 53 USPQ 6 (1942).

Therefore, any technology that was invented after the filing date of the original application could not possibly have been available for the applicant to claim in the original patent. Therefore, you can NOT claim it now in a reissue.

To be fully responsive, Applicant must correct all items mentioned above. The amendment filed on March 3, 2006 was not entered into the case because it was non-responsive so Applicant must resubmit all items concerning the amendment again, but in proper form.

Conclusion

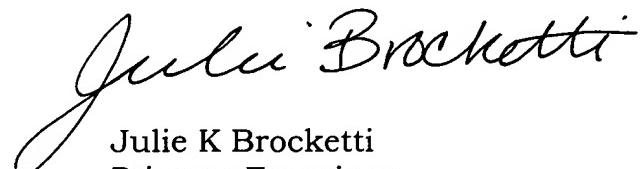
A shortened statutory period for reply to this letter is set to expire ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brocketti whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie K. Brocketti
Primary Examiner
Art Unit 3713